

REMARKS

The amendments and remarks presented herein are believed to be fully responsive to the Office Action.

Claims 1-20 are pending in the present application. Claims 1-20 have been cancelled, without prejudice. Claims 21-38 have been added. No new matter has been added. The independent claims recited by the present application are claims 21, 26, 30 and 35.

CLAIM OBJECTIONS:

The Office Action notes that several limitations lack for antecedent basis. The newly added claims have been redrafted to correct the antecedent basis, such as “a number of searches made using a representative keyword or other keywords associated with the representative keyword,” except for the limitation “the searched representative category” in claim 21, line 14; claim 26, line 16; claim 30, line 14; and claim 35, line 15 because each of those claims recite “searching the category classification database for a representative category” as a proper antecedent basis for the term “the searched representative category.”

DOUBLE PATENTING:

Claim 1 has been provisionally rejected over Applicant's co-pending U.S. Application No. 11/486,194 under the judicially created doctrine of double patenting. A Terminal Disclaimer is provided herewith which should render the rejection of the claim moot.

CLAIM REJECTIONS:

A. Claim Rejections under 35 U.S.C. § 101

The Office Action notes that the claimed invention of claims 1-12 is directed to non-statutory subject matter because these claims recites “a system”, but they fail to recite hardware component (i.e. processor, memory) in order to enable the functions to be realized.

Applicants respectfully traverse these rejections. Since claims 1-12 have been canceled without prejudice, however, the rejection thereof is moot.

Further, each of the newly added claims 21-29, which recites “a system”, recites hardware components, such as memory or processor, otherwise means-plus-function elements.

B. Claim Rejections under 35 U.S.C. § 112

The Office Action notes that claims 1-20 are indefinite for failing to particularly point out and distinctly claim the subject matter because they appear to contain incorrect English translation. Applicant respectfully adds claims 21-35 to correct faulty English translation and to particularly point out and distinctly claim the subject matter in accordance with the Examiner’s rejections. Further, Applicant also amends the specification as shown in the Substitute Specification. Particularly, Applicant amends several terms and phrases to correct faulty English translation set forth in the English translation of the PCT publication.

For example, the phrase “input orders” of keywords recited in the original translation is faulty English translation of “popularity ranks” of the keywords. As shown from Paragraph 45 of the specification and FIG. 5b., the search result page of the present invention provides with popularity ranks (521) of various search keywords, for example, the names of pop singers (522) (Seven, Lexy and Leesooyoung in FIG. 5b), associated with the representative category of the “singer” based on the prior searches made by other users. No new matter is added.

Claim Rejection under 35 U.S.C. § 103

LEGAL PRINCIPLE - To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claim combination or combine the references and the reasonable expectation of success must both be found in the prior art and not based on the Applicant's disclosure. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

With regard to the first criteria for a suggestion or motivation to modify or combine references, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kotzab, 217 F.3d 1368 (Fed. Cir. 2000). Courts and patent examiners should determine whether needs or problems known in the field and addressed by the prior art references can provide a reason for combining the elements in the manner claimed. KSR Intern. Co. v. Teleflex Inc., No. 04-1350, 2007 WL 1237837, at 4 (Apr. 30, 2007). "In formulating a rejection under 35 USC § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." Memo on KSR Decision to Examiners issued by the United States

Patent and Trademark Office, May 4, 2007. The prior art is not sufficient to establish obviousness without some objective reason to combine the teachings of the references. In re Kotzab, 217 F.3d 1368 (Fed. Cir. 2000), also see In re Sang Su Lee, 277 F.3d 1338 (Fed. Cir. 2002).

The Office Action states that claims 1-4, 6-11, 13-20 stand rejected under 35 U.S.C. 103(a), as being unpatentable over Monteverde (Publication No. US 2003/0088553) (“Monteverde”) in view of Koike et al. (Publication No. US 2005/0080773) (“Koike et al.”), claim 5 stands rejected under 35 U.S.C. 103(a), as being unpatentable over Monteverde (Publication No. US 2003/0088553) and Koike et al. (Publication No. US 2005/0080773), and further in view of Shin et al. (Publication No. US 2003/0195901), and claim 12 stands rejected under 35 U.S.C. 103(a), as being unpatentable over Monteverde (Publication No. US 2003/0088553) and Koike et al. (Publication No. US 2005/0080773), and further in view of Smith (Publication No. US 2002/0174110).

Applicants respectfully traverse these rejections. Further, claims 1-20 have been cancelled, without prejudice. Thus, the rejections thereof are moot.

Even assuming, for the sake of argument, that the rejections stated in the Office Action apply to the newly added claims 21-35, characterization of Monteverde is incorrect. Monteverde fails to disclose limitations recited in the independent claims 21, 26, 30 and 35 of the present application and Koike et al. still fails to remedy the deficiencies of Monteverde in teaching all the elements and limitations of the claims of the present invention. Neither Monteverde nor Koike et al. nor their combination disclose or teach all the elements and limitations of the claims of the present invention.

Applicants respectfully submit that Monteverde does not disclose all the elements and limitations of claim 21. For example, with regard to the element recited in claim 21 of “a keyword database including a predetermined keyword group and data indicative of a number of searches made using a representative keyword or other keywords associated with the representative keyword”, the Office Action provides a citation to Monteverde at column 19, lines 6-9. Column 19 of Monteverde recites:

[0019] In the preferred embodiment of the present invention, Internet sites and pages are assigned to at least one topical category based upon the relevancy and relatedness of the Internet site's content to the topical categories description. It is important to note that, to ensure consistency and accuracy, an Internet site may be assigned to at least one topical category and each individual underlying Internet page of that Internet site may be assigned to different topical categories based upon their respective content. Internet site promoters then view and select typical keywords deemed generally acceptable and used by other Internet site promoters within the same topical category. Assignment of the Internet site and pages to a topical category is done by either a suggestion by the Internet site promoter, whereupon such a suggestion is reviewed by the service provider, or by assignment by the service provider into a specified topical category based on a set of relevancy criteria.

According to Monteverde, the Internet site itself, not the search keyword, is assigned to at least one topical category. For example, a portal web page of Yahoo® presents a directory of topical categories wherein Internet sites are assigned to one of the topical categories. Like the topical categories of Yahoo®, Monteverde assigns the Internet sites to the topical categories based upon the relevancy and relatedness of the Internet site's content to the topical categories description. Whereas, the present invention assigns search keywords, not the Internet sites, to representative categories, such as “pop singers” or “2008 Election”. Furthermore, there is

nothing in either of references that would disclose the elements recited by claim 21, such as “a keyword database including a predetermined keyword group and data indicative of a number of searches made using a representative keyword or other keywords associated with the representative keyword” or “means for providing the user with information showing popularity of the searched keyword based, at least in part, upon the data indicative of the number of searches made using the representative keyword or other keywords associated with the first keyword group.” Mere topical categorization of the Internet web sites disclosed by Monteverde does not teach or suggest provision of the popularity index for searched keywords recited in claim 21 of the present invention. As such, the disclosure of Monteverde, *inter alia*, is insufficient to render claim 21 unpatentable. Therefore, claim 21 of the present invention is now in condition for allowance.

The other independent claims 26, 30 and 35 recite similar distinguishing elements. Thus, the same arguments apply to those claims. Therefore, claims 26, 30 and 35 of the present invention are in condition for allowance.

Claims 22-25 depend from independent claim 21 and, as such, are in allowable condition since claim 21 is clearly allowable over the cited prior art.

Claims 27-29 depend from independent claim 26 and, as such, are in allowable condition since claim 26 is clearly allowable over the cited prior art.

Claims 31-34 depend from independent claim 30 and, as such, are in allowable condition since claim 30 is clearly allowable over the cited prior art.

Claims 36-38 depend from independent claim 35 and, as such, are in allowable condition since claim 30 is clearly allowable over the cited prior art.

Therefore, claims 21-38 of the present invention are now in condition for allowance.

In light of the aforementioned amendments and discussion, Applicant respectfully submits that the application is now in condition for allowance.

If any issue regarding the allowability of any of the pending claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's amendment, or if the Examiner should have any questions regarding the present amendment, it is respectfully requested that the Examiner please telephone Applicant's undersigned attorney in this regard.

Respectfully submitted,

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